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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,376	08/21/2003	Volker Stade	11349-18-999	8582
20583	7590	06/21/2007		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER OSELE, MARK A	
			ART UNIT 1734	PAPER NUMBER
			MAIL DATE 06/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/646,376	STADE, VOLKER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Osele	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9, 11-18 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-18, 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date, _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5, 7-8, 11-12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Manusch et al. (US 6,105,650). As to Claim 1, Manusch et al. '650 discloses a hand-held device for transferring a film (Figure 2, tape 7) from a backing tape (Figure 2, carrier tape 6) onto a substrate (Figure 2, substrate 8), the device comprising a housing in which a supply of the backing tape is arranged (column 5, lines 36-39); and an application member (Figure 2, applicator foot 11) projecting from the housing and having a shaft and at least a free end, a first application edge (Figure 2, application toe 4a) and a second application edge (Figure 2, application toe 4b), the backing tape being wound around the free end and the application edges of the application member and extending into the housing with tape sections at a lower longitudinal side of the application member facing the substrate during operation and at an upper longitudinal side of the application member opposite the lower longitudinal side; wherein the second application edge (Figure 2, application toe 4b) projects from the lower longitudinal side of the application member (column 6, lines 32-61) and the first and second application edges are arranged asymmetrically in relation to a

Art Unit: 1734

longitudinal axis of the application member (Fig. 3; column 7, lines 26-41; column 8, lines 13-23 in particular lines 13-16).

Regarding claim 5 the second application edge has a height greater than a cross-sectional dimension of the first application edge.

Regarding claims 7-8 the second application edge has a wedge-shaped cross-sectional shape.

Regarding claims 11-12, the front end portion of the application member is movable upwards against an elastic restoring force (column 6, lines 40-53).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, 9, 15, and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Manusch et al.

(6,105,650). As to claims 2 and 3, as shown in paragraph 2 above, Manusch et al. '650 discloses a hand-held device wherein the first and second application edges (Figure 2, applicator toes 4a and 4b) have mid-central planes enclosing an angle. Although not clearly shown, the angle appears to be approximately 90°. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 1734

adjust the angle of Manusch et al. '650 to within the claimed range because Manusch et al. '650 further teaches that it may be advantageous to rotate one application edge with respect to the other (column 8, lines 13-23)

Regarding claim 9, Manusch et al. '650 appears to show the second application edge extending beyond either the lower border of the housing or the bottom side of the housing. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the second application edge extend beyond the housing because this is the conventional orientation for a hand-held film transferring apparatus.

Regarding claim 15, in Fig. 2, Manusch et al. '650 appears to show the second application edge, 9a, offset backward in relation to the first application edge, 9b. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the second application edge offset backward in relation to the first application edge because Manusch et al. '650 teaches that the two application edges can be movable to each other for alternative application methods (Fig. 3; column 7, lines 36-41).

Regarding claim 27, Manusch et al. '650 shows in Fig. 3 that the application member and second application edge are not integral with each other, but this is disclosed as "...an embodiment for the arrangement as a whole..." (column 7, lines 26-27). The use of the article "an" suggests that other embodiments are contemplated, such as the integral embodiment of Fig. 1. Furthermore, Manusch et al. '650 discloses that integral and non-integral constructions of the application feet and application toes

Art Unit: 1734

are interchangeable (column 6, lines 52-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the application member and second application edge integral because Manusch et al. '650 discloses that integral or non-integral construction is a choice for one of ordinary skill.

5. Claims 6, 14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch et al. (US 6,105,650) in view of Kobayashi (JP11-157290). Manusch et al. '650 discloses a hand-held device for transferring a film from a backing tape onto a substrate but fails to show the mounting means for the application member. Regarding claim 6, Kobayashi discloses the application member has a shaft (Figure 2, plate-like member 17); and the height of the third application edge (Figure 2, pressing part 15) is greater than the cross-sectional dimension of the shaft of the application member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mounting means of Kobayashi in the apparatus of Manusch et al. '650 because Manusch et al. '650 shows that a particular mounting means is not required for the shown application member and Kobayashi shows the claimed mounting means to be effective to connect an application member to the housing.

As to Claim 14, Kobayashi disclose a hand-held device which includes at least one guiding web (Figure 2, guides 18) projecting backwards from a backside of the application edge on at least one side, the guiding webs having an inner side guiding the backing tape being wound around the second application edge. It would have been

Art Unit: 1734

obvious to one of ordinary skill in the art at the time the invention was made to add the guiding web of Kobayashi into the apparatus of Manusch et al. '650 to ensure that the film does not slip off the application member.

As to Claim 17, Kobayashi discloses a hand-held device wherein the application member is formed with a necking (see Figure 1, transfer head 5).

As to Claim 18, Kobayashi discloses a hand-held device wherein the application member has a rear end closer to the housing than the front end; and the necking is formed at the rear end of the application member (see Figure 1, transfer head 5).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manusch et al. (US 6,105,650) in view of Manusch et al. (5,462,633). Manusch et al. '650 discloses a hand-held device for transferring a film from a backing tape onto a substrate but fails to suggest the claimed mounting of the application member. Manusch et al. '633 also discloses a hand-held device for transferring a film from a backing tape onto a substrate wherein the application member is mounted upwards against an elastic force to ensure good adherence of the film while avoiding deformation of the film (column 3, lines 18-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to mount the application member Manusch et al. '650 upwards against an elastic force as suggested by Manusch et al. '633 to ensure good adherence of the film while avoiding deformation of the film during the application process.

***Response to Arguments***

7. Applicant's arguments filed February 14, 2007 have been fully considered but they are not persuasive. Applicant argues that claim 1 should be allowable because the embodiment of Fig. 1 of Manusch et al. '650 is symmetrical while the embodiments of Figs. 2 and 3 are asymmetrical but not integral. Instant claim 1 does not require that the two application edges be integral, but only that the second application edge projects from the lower longitudinal side of the application member, which is what the embodiment of Figs. 2 and 3 shows.

Applicant also argues that Manusch et al. '650 does not show the limitations of claim 27 because the embodiments of Figs. 2 and 3 show application edges which are not integral. Applicant appears to be arguing that Manusch et al. '650 does not anticipate claim 27. This is not the rejection of claim 27. Claim 27 is rejected as being obvious over Manusch et al. '650. This obviousness is not argued by applicant.

In addition, it is noted that the term integral does not appear in applicant's specification and is, therefore, not defined by applicant. Without such a definition in the disclosure one must interpret integral from common use. According to Webster's New World Dictionary, Third College Edition, 1988, integral is defined as: 1.) necessary for completeness; essential; 2.) whole or complete; 3.) made up of parts forming a whole; 4. ) Math. a) of or having to do with an integer or integers; not fractional b) of or having to do with integrals or integration. A broad interpretation of "integral" according to common usage could include the embodiment of Figs. 2 and 3 of Manusch et al. '650



wherein a connector integrally attaches the two application members. Nothing in the definition of integral overcomes the rejection of the instant claims.


***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 15, 2007

  
**MARK A. OSELE**  
**PRIMARY EXAMINER**